REMARKS

Claims 1-3, 5, 6, 9 and 12-25 are now in the application. Claims 4, 7, 8, 10 and 11 have been canceled without prejudice or disclaimer. Claim 5 has been amended to recite "directly downstream". Claim 5 has also been amended to recite "mixture consisting essentially". In addition, claim has been amended to recite "to incorporate an organic blowing agent into the polymer melt" for purposes of clarification. Claim 5 has also been amended to recite "a die plate" in place of "a die" for purposes of clarification. Claim 13 has been amended to recite "150 to 200°C" as disclosed at page 6, lines 26-27 of the specification. Claim 16 has been amended by deleting "300", which was a typographical error. Newly presented claims 17-25 find support in the specification at page 5, lines 20-34. The amendments to the claims and newly presented claims do not introduce any new matter.

Claims 5, 7, 10-11, 13 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent 5,525,637 to Henn et al. (hereinafter also referred to as "Henn"). Claim 8 is rejected under 35 U.S.C. § 103(a) as being obvious over Henn et al. (US 5,525,637). Henn fails to anticipate and fails to render obvious claim 5 and claims dependent thereon.

The comments in the office action concerning "product by process" claims seems to be misplaced since claim 5 and claims dependent thereon are process claims and not "product by process claims."

Henn relates to an expandable styrene polymer for elastic polystyrene foams. It therefore contains as component b) from 5 to 30% by weight of at least one styrene- soluble elastomer, comprising a polybutadiene rubber as an essential component (Claim 1). This is in contrast to the mixture used in step a) of Claim 5 of the present invention which consists essentially of 50 to 90 wt.% of polystyrene B) and 10 to 50 wt.% styrene copolymer A). It should be noted that the language "comprising in claim 5 relates to the claimed process steps and not to the mixture in step a). To clarify this point, claim 5, as mentioned above, has been amended to recite "consisting essentially of" with respect to the mixture in step a).

Moreover, the specific process conditions mentioned in steps b) to e) are not disclosed in Henn. The possibility of adding the blowing agent to the molten polymer is only generally mentioned in Henn at Col 5, lines 27 to 29. The preferred method of Henn, however, is the subsequently described impregnation method. For the impregnation, the granules are suspended in water and a blowing agent is injected at an elevated temperature as described in Col 5, lines 38 to 47 and in Col 6, lines 53 to 63. This means that the blowing agent is not mixed into the polymer melt and the granulation step is carried out with the polymer melt without a blowing agent before the impregnation step.

Henn does not suggest the specific temperatures and pressures of the current process and does not teach using a blend without polybutadiene rubber. A process, which comprises the steps of incorporating an organic blowing agent into the polymer melt and pelletizing this melt under water and pressure, is not taught or suggested by Henn. The process of the present invention therefore is novel and non-obvious.

Henn fails to anticipate the present invention. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. *See Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. *See Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984). The cited art must clearly and unequivocally disclose the claimed invention without any need for picking and choosing and combining various disclosures from the reference. Please see Net MoneyIn v. VeriSign, Inc. et al. 545 F.3d 1359 1371, 88 USPQ2d 1751 (Fed. Cir. 2008).

In addition, as stated in *Ex parte Levy*, 17 USPQ2d 1461 (USPTO Board of Patent Appeals and Interferences, 1990) "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied references." This has not

been done in the present case. In fact, even when a single prior art reference contains all elements "that could have been arranged" as claimed, anticipation is still not found unless the manner in which elements are arranged or combined as claimed is disclosed either expressedly or inherently. Please see *Therasense Inc. v. Becton, Dickinson and Co.* 93 USPQ2d 1481 (Fed. Cir. 2010). Also see *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.* 730 F.2d 1452, 1459; 221 USPQ 481 (Fed. Cir. 1984), *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193 (Fed. Cir. 1983) and *NetMoneyIN Inc. v. Verisign, Inc.,* supra.

Claim 14-15 are rejected under 35 U.S.C. § 103(a) as being obvious over Henn et al. and further in view of US Patent 6,340,713 to Glück et al. (hereinafter also referred to as "Gluck"). The cited references do not render obvious claims 14 and 15. Gluck was relied upon for a disclosure of passing a polymer melt through the die plate at a temperature in the range from 140 to 300°C and granulating under a pressure of 5 bar and underwater. However, Gluck fails to over come the above discussed deficiencies of Henn with respect to rendering unpatentable the present invention. Accordingly, claims 14 and 15 are patentable for at least those reasons as to why claim 5 is patentable.

Claim 16 was rejected under 35 U.S.C. § 103(a) as being obvious over Henn and further in view of US Patent to 4,284,553 to Loo. The cited reference do not render obvious claim 16. Loo relates to a process of extruding and granulating thermoplastic material. Leo does not teach granulation of a blowing-agent containing polymer melt and also does not teach granulation under pressure. A blowing-agent containing a polymer melt however tends to expand with lower pressure and/or higher temperature Persons skilled in the art would therefore not heat the die plate because of the risk of premature expansion. Furthermore, Loo fails to over come the above discussed deficiencies of Hen with respect to rendering unpatentable the present invention. Accordingly, claim 16 is patentable for at least those reasons as to why claim 5 is patentable.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Commissioner is hereby authorized in this paper, to charge payment or credit any overpayment to Deposit Account No. 22-0185, under Order No. 12810-00266 US from which the undersigned is authorized to draw.

Dated: September 2, 2010

Respectfully submitted,

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